

REMARKS/ARGUMENTS

The office action of January 21, 2004 has been reviewed and these remarks are responsive thereto. Reconsideration and allowance of the instant application are respectfully requested.

Claims 2-55 remain in this application. By this amendment, claims 2, 9, 24 and 45-47 have been amended and new claims 56-60 have been added.

Claims 2-55 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5, 991,737 to Chen (Chen) combined with U.S. Patent No. 5,812,931 to Yuen (Yuen). Applicants respectfully traverse these rejections.

With regard to claims 2, 5, 9, 10, 16-17, 24, 25, 33, 45 and 51, the Office Action correctly states, “Chen does not mention the steps of sending a connection request to the device associated with the broadcast program and receiving a connection response from the device associated with the broadcast program, and the connection between the mobile device and the device associated with the broadcast program is a two-way wireless connection.” The Office Action subsequently only relies on Yuen to address the identified “two-way wireless connection” deficiency of Chen.

The Office Action relies on the teachings of Chen alone regarding the identified deficiencies of “sending a connection request to the device associated with the broadcast program and receiving a connection response from the device associated with the broadcast program,” which the Office Action has already conceded are absent from Chen. Instead, the Office Action argues that because “Chen discloses the hand-shaking process between the call server and the device associated with the broadcast program, it would be obvious to establish [these] steps.” Such a position is untenable, at least because Chen does not disclose the hand-shaking process suggested in the Office Action, there is no motivation for such a modification, and it is unclear how such a proposed modification would be carried out to provide the claimed invention.

The Office Action points to figs. 1-2 and col. 4, lines 24-29 for support that Chen discloses “hand-shaking with a device 12, 14 associated with a broadcast program.” However, in this section Chen describes a process of order fulfillment in which processing station 22 either

sends a product or information directly to the consumer or communicates an order to media content originator 12. (*See Chen, col. 4, lines 24-27*). Other than identifying communication of an order to the media content originator, Chen is silent on the type of communication between processing station 22 and media content originator 12 or any handshaking between the two. With regard to claims 2 and 5, which recite a call server that sends a request to a broadcast program to establish two-way communication with a device and receives a response to the request, it is entirely unclear how a modification to Chen's system for ordering products or responding to broadcast information could be carried out to provide the claimed invention; that is, there is no expectation of success of such a modification. Further, Chen does not provide any motivation to undertake such a modification in the first place.

Moreover, the proposed modification to Chen would not result in the claimed invention of at least claim 2. Presumably, such a hypothetical system would provide for communicating a product or information order from processing station 22 to media content originator 12. In contrast, claim 2 as amended recites "receiving a response to the second request from the device associated with the broadcast program for establishing a two-way wireless connection to the mobile device."

Accordingly, Applicants respectfully submit that at least independent claim 2, as well as claims 3-8, 36-38, 51-54 and new claims 56-60 depending therefrom, are allowable over the prior art of record.

With regard to claims 2, 5, 9, 10, 16-17, 24, 25, 33, 45 and 51, the Office Action states that it would be obvious "to apply the Yuen's teaching in modifying the Chen's system particularly the connection between the mobile device and the device associated with the broadcast program for the advantage of allowing the user to access new information via the established link as well as eliminating a need of creating a new RF link between the user and the broadcast center." However, this is an end-result of a combination of Chen and Yuen, not a motivation or suggestion to combine the references in the first place. In addition, it is entirely unclear how such a modification to Chen's system for ordering products or responding to broadcast information would be carried out, i.e., there is no expectation of success in the

combination. Moreover, a combination of Chen with Yuen would not produce the claimed invention according to these claims.

Chen discloses a system and method for ordering products related to a broadcast radio or TV program through a process station, which does not include a connection between a consumer and a media facilitator (e.g., a radio station) beyond reception of non-interactive broadcast media by the consumer, and which does not include two-way or an interactive connection between a consumer and the media facilitator. As shown in Fig. 1 and discussed at col. 4, lines 9-29 of Chen, order data is sent from consumer 24 via consumer transmitter 18 to processing station 22. Processing station 22 can send feedback or an acknowledgment to consumer 24. However, Chen does not disclose or suggest any connection between the media facilitator 14 (e.g., "television stations, radio stations, and billboards," col. 3, lines 12-13) and the consumer 24 beyond non-interactive broadcast transmissions, nor does it disclose or suggest transmission of any requests for a connection between a consumer and the media facilitator.

Chen does not provide any indication that it would be desirable to provide two-way communication between the media facilitator and the consumer in addition to the disclosed ordering system, and it is entirely unclear how this would even be accomplished. The proposed modification of Chen's system to provide two-way communication between the media facilitator and the consumer amounts to an impermissible attempted hindsight reconstruction of the claimed invention. As has been noted, it is unclear how such a combination could be accomplished, much less be obvious to one of ordinary skill in the art. At best, the combination would seemingly destroy or render superfluous the disclosed function of Chen's elaborate ordering system.

Yuen discloses a two-way interactive television system based on pager technology. Yuen teaches sending a message from a pager transmitter (16) to an Information Provider (38) through a Network Operator Center (37) and vice versa. However, Yuen does not describe sending any requests to establish two-way communication or receiving a response containing connection information. Further, Yuen does not provide any indication that it would be desirable to implement a request system for establishing two-way communication between the information

provider and the pager transmitter/receiver, and it is unclear how this would even be accomplished in the system of Yuen, either alone or in combination with Chen.

Moreover, a combination of Chen and Yuen as proposed would not result in the claimed invention. Presumably, such a hypothetical system would include the product ordering system of Chen that would include text messaging between the consumer transmitter/receiver and the processing station. In contrast, the inventive mobile device, computer-readable medium and call server of claims 2, 5, 16-17, 24-25 and 51 provide for requesting a two-way connection, receiving a response to the request, and establishing the two-way connection.

Accordingly, Applicants respectfully submit that independent claims 2, 9, 16, 24, 33 and 45, and claims 3-8, 10-15, 17-23, 25-32, 34-44, 46-60 depending therefrom, are allowable over the prior art of record.

In addition to the above-stated reasons, claims 3, 11, 19, 27, 33, 46 and 47 are allowable over the prior art of record, because neither Chen nor Yuen disclose or suggest requesting and establishing two-way telephony or voice communication between a mobile device and a broadcast program. The Office Action suggests that Chen discloses transmitting broadcasts in receivable forms, and that telephony is a receivable form. However, this argument is untenable because both Chen and Yuen teach that the broadcasts are "ordinary television, radio and billboards, rather than specialized, interactive media distribution channels." Chen, col. 1, lines 61-64. For this additional reason, claims 3, 11, 19, 27, 33, 46 and 47 are allowable over the prior art of record.

In addition, claims 36-44 and 48-50 are allowable for the further reason that neither Chen nor Yuen disclose or suggest the additional information in the request to establish a two-way connection as recited in these claims. The Office Action points to col. 5, lines 1-15 of Chen and argues that Chen discloses additional information sent from a consumer transmitter that may include a summary of an intended topic or location information. However, this portion of Chen teaches user entry of data specifying the broadcast information (e.g., radio station call letters) or account information. As such, Chen does not teach or suggest the additional information recited in these claims that is part of the request to establish a two-way connection, and Yuen does not

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overcome the deficiencies of Chen. For this additional reason, Applicants respectfully submit that claims 36-44 and 48-50 are allowable over the prior art of record.

Further, claims 6 and 54 are allowable for the further reason that neither Chen nor Yuen disclose or suggest the defined delay time recited in these claims. The Office Action suggests that delay times are inherent. However, the defined delay time, and a delay time defined by the broadcast program, as recited in these claims is not inherent. As described in paragraph 26 of the specification, defined delay times can provide advantages, such as providing the user with an option for indicating when to submit their request to a show or for providing a game show host control over the time to call participants. For this additional reason, Applicants respectfully submit that claims 6 and 54 are allowable over the prior art of record.

As to claim 53, in addition to the arguments set forth above, the Office Action states, “[t]he step of exiting the connection is a common sense step.” The Examiner appears to take the position that it is common knowledge in the art but no references are cited to support this contention. It is respectfully submitted that it is not common knowledge in the art for a call server to exit a connection between a device and a broadcast program. A connection between a device and a broadcast program would typically be exited by either the device or the broadcast program rather than the call server. This is further demonstrated by the fact that neither of the cited prior art references teaches or suggests what the Examiner asserts is common knowledge. It is requested that if the Patent Office maintains this position, that a reference be supplied to support the assertion that such is “common knowledge.”

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Based on the foregoing, Applicants respectfully submit that the application is in condition for allowance and a Notice to that effect is earnestly solicited. Should the Examiner believe that anything further is desirable in order to place the application in even better form for allowance, the Examiner is respectfully urged to contact Applicants' undersigned representative at the below-listed number.

Respectfully submitted,

BANNER & WITCOFF, LTD.

Dated: *April 21, 2004*

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